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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/521,386   | 01/18/2005  | Valerie Sacrez-Liebhold | PU020345            | 2347             |
| 7590 10/13/2010  |             |                         |                     |                  |
| Joseph S Tripoli<br>Thomson Licensing Inc<br>Two Independence Way<br>Princeton, NJ 08540 |             |                         |                     |                  |
| EXAMINER   |             |                         |                     |                  |
| FINDLEY, CHRISTOPHER G   |             |                         |                     |                  |
| ART UNIT   |             | PAPER NUMBER            |                     |                  |
| 2482   |             |                         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/521,386

**Applicant(s)**

LIEBHOLD, VALERIE SACREZ

**Examiner**

CHRISTOPHER FINDLEY

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 7/26/2010 have been fully considered but they are not persuasive.
2. Re claim 1, the Applicant contends that the prior art fails to teach or suggest providing, in response to the digital video recording apparatus being placed in a power ON state, an initial on screen display message indicating a numerical value representing a number of available video programs stored in the storage device. The Applicant points out that the user may determine the number of available programs associated with the apparatus by counting the number of thumbnails (Applicant's remarks, page 6, lines 14-17). The Examiner respectfully counters that it was well known at the time of filing that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 120 USPQ 192 (CCPA 1958). Accordingly, the automated process of counting the available programs and determining the number of available programs is deemed to be not patentably distinct from the prior art cited.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. **Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al. (US 7158713 B2, hereinafter referred to as "Goto") in view of Ettlinger (US 4746994 A).**

Re **claim 1**, Goto discloses a method for controlling a digital video recording apparatus, comprising the steps of: receiving a plurality of signals corresponding to a plurality of video programs from a signal source (Goto: Fig. 1, tuner 11, IN 1 and IN 2); selecting ones of the plurality of video programs for

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recording in response to user commands (Goto: column 5, lines 39-45 and column 6, lines 18-24); storing the selected video programs in a storage device (Goto: column 5, line 65-column 6, line 18); and maintaining data related to the video programs stored in the storage device (Goto: column 10, lines 15-23).

Goto additionally discloses an editing page, which displays thumbnail images of the stored content (Goto: column 14, lines 30-32), but Goto does not explicitly disclose providing, in response to the digital video recording apparatus being placed in a power ON state, an initial on screen display message indicating available video programs stored in the storage device. However, Ettlinger discloses a computer-based video editing system, wherein a start-up screen displays disk contents, showing the files that are present on the disk (Ettlinger: column 20, lines 11-15). Since both Goto and Ettlinger relate to video editing systems, one of ordinary skill in the art at the time of the invention would have found it obvious to incorporate Ettlinger's start-up display in the system of Goto in order to provide faster, more efficient editing of stored content (Ettlinger: column 2, lines 33-37).

While neither Gotoh nor Ettlinger explicitly discloses a numerical value representing a number of available video programs stored in the storage device, as the Applicant has previously pointed out, the user may determine the number of available programs associated with the apparatus by counting the number of thumbnails. However, it was well known at the time of filing that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Verner*, 120 USPQ 192 (CCPA 1958). Accordingly, the automated process of counting the available programs and determining the number of available programs is deemed to be not patentably distinct from the prior art cited.

Re **claim 2**, Goto discloses that the indication of available programs comprises a number of video programs stored in the storage device since the last time the apparatus was in the power ON state (Goto: column 14, lines 40-57, there is a maximum number of programs, wherein the user may navigate among the stored programs by use of a cursor).

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Re **claim 3**, Goto discloses that the initial on screen display message further displays selected attributes of the available video programs stored in the storage device (Goto: Figs. 4-7 with column 9, lines 27-31 and column 10, lines 15-23, the display screen shows auxiliary information such as date and time).

Re **claim 4**, Goto discloses that the selected attributes include titles of the available video programs (Goto: Figs. 4-7 and column 9, lines 27-31, the thumbnail images may show titles).

Re **claim 5**, Goto discloses that the selected attributes includes times the available video programs were stored in the storage device (Goto: column 9, lines 27-31, recording date and recording time).

Re **claim 6**, Goto discloses that the number of available video programs comprises a number of video programs stored in the storage device since a last time a user accessed a full program listing display of all programs stored on the storage device (Goto: column 14, lines 40-57, there is a maximum number of programs, wherein the user may navigate among the stored programs by use of a cursor).

**Claim 7** has been analyzed and rejected with respect to claim 3 above.

**Claim 8** has been analyzed and rejected with respect to claim 4 above.

**Claim 9** has been analyzed and rejected with respect to claim 5 above.

**Claim 10** recites the corresponding apparatus for implementing the method of claim 1 above. Arguments analogous to those presented for claim 1 are applicable to claim 10, and therefore claim 10 has been analyzed and rejected with respect to claim 1 above.

**Claim 11** has been analyzed and rejected with respect to claim 2 above.

**Claim 12** has been analyzed and rejected with respect to claim 3 above.

**Claim 13** has been analyzed and rejected with respect to claim 4 above.

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**Claim 14** has been analyzed and rejected with respect to claim 5 above.

**Claim 15** has been analyzed and rejected with respect to claim 6 above.

**Claim 16** has been analyzed and rejected with respect to claim 7 above.

**Claim 17** has been analyzed and rejected with respect to claim 8 above.

**Claim 18** has been analyzed and rejected with respect to claim 9 above.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER FINDLEY whose telephone number is (571)270-1199. The examiner can normally be reached on Monday-Friday (8:30 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2482

/Christopher Findley/